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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,005

04/15/2004

Theodore A. Chapman

M-15340 US

7290

7590

12/28/2005

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,005	<b>Applicant(s)</b> CHAPMAN ET AL.	
	<b>Examiner</b> Daniel I. Walsh	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-15,17,18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-15,17,18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 11 October 2005.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 4, 6-15, 17, 18, 20-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12, 6, 7, 9-14, 15, 23, 25, 26, 27, 28, 29, 30, 31, of copending Application No. 10/865,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious that though claim 1 of the current Application is silent to an optically readable label printer coupled to the host computer, and that the applicator is an RFID label applicator coupled to the host computer, the Examiner notes it is obvious that in order to print a readable label that a

optically readable label printer is provided, and that the applicator is coupled to the host computer in order to apply the labels to objects. Re claim 8 and 18, the Examiner notes it would have been obvious for the optically readable label to be a barcode, as is conventional in the art, for storing coded data optically. Re claim 9, though silent to a container, the Examiner notes that barcodes/RFID tags can be applied to various items/objects. It would have been obvious to apply to a container in order to provide identification information for the container. Re claim 10, the Examiner notes that it is obvious that the label needs to be readable in order for the information to be verified/read. Re claim 15, though the current Application is silent to transmitting data from the label to the computer, the Examiner notes that it would have been obvious to do so to verify the programming of the label.

I) Claim 1 of the present Patent Application claims: "An RFID labeling system...RFID encoder...RFID label applicator...host computer...different programming languages." (see claim 1), whereas the '015 Patent Application claims: "An RFID printer system...RFID encoder...host computer...different programming languages" (see claim 1), and "...label printer and applicator coupled to the host computer..." (see claim 12).

II) Claim 15 of the present Patent Application claims: "...receiving a signal...data stream in a programming language...programming the RFID...applying...determining...determining...applying..." (see claim 15), whereas the '015 Patent Application claims: "...receiving...programming...transmitting...determining...determining...applying..." (see claim 15) and "...data stream in a programming language." (see claim 22).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR. in view of Hohberger.

The teachings of Dunlap/Hohberger have been discussed in the previous Office Action. Dunlap teaches printing an optically readable label (paragraph [0020]). It would have been obvious to send the signal from a host computer, which is where the programming would be generated. Dunlap teaches each dispensed 10 coupled to the control prints the barcode and

programs the RFID tag, and thus is understood to receive a data stream, and FIG. 2 includes an applicator, as it is obvious to apply the label.

Dunlap JR is silent to verifying that the RFID label has been properly programmed and applying the label if properly programmed.

Hohberger et al. teaches verifying a RFID transponder before attaching/printing (FIG. 7). It would have been obvious that this is verified based on data stream information to verify the programming matches.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR. with those of Hohberger et al.

One would have been motivated to do this in order to ensure the correctness of the RFID label.

Though silent to different languages, the Examiner notes that it is well known and conventional that different programming languages can be used to print information and encode tags. As the claim merely recites that the information can be of different programming languages, the Examiner notes that different devices/units would obviously use different programming languages, in accordance with their needs. Unlike the independent claim 1 claim 27 does not teach that the RFID encoder (of one device/unit) is able to extract information from streams of different programming languages.

Re claim 29, it is obvious that after the RFID is written, it is verified, as discussed in the previous Action, to ensure the RFID is correct.

4. Claims 28, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR./Hohberger et al., as discussed above, in view of Kimura et al.

The teachings of Dunlap, JR./Hohberger et al. have been discussed above.

Dunlap, JR./Hohberger et al. fail to teach determining whether the optical label was printed properly.

The teachings of Kimura et al. have been discussed in the previous Office Action including verifying a printed barcode. Kimura et al. teaches that barcodes are verified after printing as either correct or ineffective (abstract) to reduce errors.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Dunlap, JR./Hohberger with those of Kimura et al.

One would have been motivated to do this to ensure the barcode was correctly printed, to reduce errors.

Re claim 31, it is clear that verifying unit 23 of Kimura scans the optical label.

Re claim 32, though Hohberger teaches that the RFID is verified by comparing is with data written (interpreted as using a data stream, as it is understood that the written data is compared to that expected to be written), and is silent to a similar procedure for barcodes/optical data, the Examiner notes that it would have been obvious to one of ordinary skill in the art to apply the verification of one type of encoded data (RFID) to another type of encoded data (barcode/optical) motivated by the desire to ensure correct data writing.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, JR./Hohberger et al., as discussed above, in view of Jusas et al.

The teachings of Dunlap, JR./Hohberger et al. have been discussed above.

Dunlap, JR./Hohberger fail to teach comparing the barcode and RFID.

The teachings of Jusas et al. have been discussed in the previous Office Action including comparing the RFID and barcode/optical code (paragraph [0012]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Dunlap, JR./Hohberger et al. with those of Jusas et al.

One would have been motivated to do this in order to verify the encoded and printed data.

### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In addition to the double patenting rejection above, the Examiner notes that claim 27 merely recites a method, where the data stream can be of different languages. As it is recognized in the art, and the Applicants own specification, different programming languages are well known and conventional in the art. Accordingly, the Examiner notes that claim 27 is broadly interpreted as claiming different programming languages can be used, as the claim does not limit itself to an RFID encoder that is able to extract information from data streams of different programming languages, which is versatile, versus a claim that can be read as different programming languages can be used for programming the labels, but not necessarily that one device handles and is able to extract data from streams of different programming languages.

The Examiner regrets any delay.



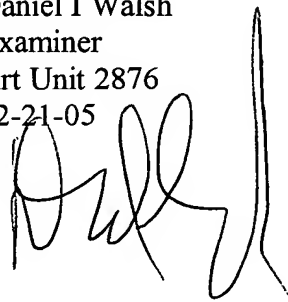
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh  
Examiner  
Art Unit 2876  
12-21-05

A handwritten signature in black ink, appearing to read 'D. Walsh', is written over the printed name and date.